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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Frank-Lin Distillers Products, Ltd.

Serial No. 76419825

Robert A. Nakamae of Robinson & Wood, Inc. for Frank-Lin Distillers Products, Ltd.

Georgia Ann Carty Ellis, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Drost, Zervas, and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 12, 2002, Frank-Lin Distillers Products, Ltd. (applicant) applied to register the mark BEYOND VODKA in standard character form on the Principal Register for "vodka" in Class 33. The application (Serial No. 76419825) contains a date of first use of April 15, 2002, a date of first use in commerce of May 7, 2002, and a disclaimer of the term "Vodka."

The examining attorney ultimately refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of a registration for the mark BEYOND MERLOT in standard character form for "wine" in Class 33. The registration (No. 2,791,995) issued December 9, 2003, and the term "Merlot" is disclaimed.

After the examining attorney made the refusal final, this appeal followed.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The examining attorney argues (Brief at 3) that:

[T]he descriptive wording in each of the respective marks has been disclaimed and the dominant portion of the marks is the term "BEYOND." There is no distinction between the dominant wording in the applicant's mark and the dominant wording in the registered mark.

The examining attorney also submitted numerous trademark registrations to support her argument that the goods (vodka and wine) are related.

Applicant, on the other hand, points to numerous differences between vodka and wine and argues that the examining attorney erred by relying "upon a comparison of BEYOND only." Brief at 8.

We will begin our analysis by considering the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression." Majestic Distilling, 65 USPQ2d at 1203. When we compare the marks, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The marks in this case consist of two words each, BEYOND VODKA and BEYOND MERLOT. Neither claims a design or stylization so the marks contain the identical common term BEYOND followed by a different, disclaimed term VODKA and MERLOT. The term BEYOND does not appear to have any meaning in relation to alcoholic beverages.

Regarding the additional wording "Vodka" in applicant's mark and "Merlot" in the cited registration,

both terms have been disclaimed. Not only are the terms disclaimed, the terms are also generic for their respective alcoholic beverages. Certainly, "Vodka" is the generic name for "Vodka," and "Merlot" is a generic term for a type of wine.¹ We do not disregard these terms, but disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code Consultants, Inc., 60 USPQ2d 1699, 1702 (TTAB 2001). Furthermore, descriptive terms are often given less weight in likelihood of confusion analyses. The Federal Circuit held that the addition of the word "Swing" to registrant's mark "Laser" did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted).

¹ Merlot is defined as "a dark-blue grape used in winemaking, esp. in the Bordeaux region of France and in areas of Italy, Switzerland, and California." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). In this case, the terms "Vodka" and "Merlot" are generic for vodka and Merlot wine respectively and they have much less commercial significance. In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Because ALE has nominal commercial significance, the Board properly accorded the term less weight in assessing the similarity of the marks under Du Pont. As a generic term, ALE simply delineates a class of goods").

We conclude that the term "Beyond" would clearly be the dominant term in the marks BEYOND VODKA and BEYOND MERLOT. In addition, the marks are similar in sound and appearance to the extent that they begin with the identical dominant term "Beyond." Obviously, the terms "Vodka" and "Merlot" would be different, but the addition of a generic name for the respective products would not serve to significantly distinguish the marks if the goods themselves

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are related. Furthermore, the meaning and commercial impression of the marks would likewise be similar. The term "Beyond" would seem to suggest that the goods are something more than ordinary "Vodka" or "Merlot."

When we compare the marks BEYOND VODKA and BEYOND MERLOT in their entireties, we conclude that the marks are similar. In re Denisi, 225 USPQ 624, 624 (TTAB 1985) (If "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences"). See also Chatam International, 71 USPQ2d at 1946 ("With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." The marks JOSE GASPAR GOLD and GASPAR'S ALE were determined to be similar).

We add one other factor that supports a determination that the marks are similar. Applicant's specimen shows the mark displayed in such a way that the BEYOND portion of its mark is emphasized. In re Nationwide Industries, 6 USPQ2d 1882, 1884 (TTAB 1984) ("Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to

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purchasers"). The specimen shows BEYOND in larger horizontal script across the middle portion of the bottle with the word VODKA in smaller, vertical block type at the bottom of the bottle (see below).



Prospective purchasers encountering the specimen would see that the specimen emphasizes the term BEYOND. Therefore, we conclude that the marks, dominated by the identical term BEYOND, are similar in sound, appearance, meaning, and commercial impression.

Another important consideration is whether the goods of applicant and registrant are related. It is not critical that the goods be identical or interchangeable. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some

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association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001).

When we consider the goods, we must consider them as they are identified in the identification of goods in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); Dixie Restaurants, 41 USPQ2d at 1534 (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be").

Importantly in this case, the goods are identified simply as "vodka" and "wine." Therefore, we consider the goods to be unrestricted as to the price or quality of the wine and vodka and the goods would include relatively inexpensive wine and vodka that would be purchased on impulse by purchasers who were not very discriminating or

sophisticated purchasers. Thus, the question is simply whether vodka and wine are related products.

To support her conclusion that the goods are related, the examining attorney has submitted numerous trademark registrations to show that the same entities have registered a common mark for vodka and wine. We have held that although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source." In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993); In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001) ("The registrations show that entities have registered their marks for both television and radio broadcasting services. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein, including television and radio broadcasting, are of a kind which may emanate from a single source").

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We highlight several of these registrations including: No, 2,517,580 for "Rice wine saki, red wine, white wine, whiskey, vodka, brandy, and gin"; No. 2,865,432 for "Liqueurs, wine and vodka" and consulting and other services in the field of alcoholic beverages; No. 2,795,343 for "Distilled spirits, namely, cordials, liqueurs, tequila, rum, vodka, scotch, bourbon, whiskey, brandy, rum, gin; and wine"; No. 2,775,036 for "vodka, gin, scotch, whiskey, bourbon, rye, whiskey, rum, wine"; No. 2,505,385 for "wine, rum, vodka, prepared alcoholic cocktails, schnapps, gin, whiskey, tequila, mescal and pulque"; No. 2,402,053 for "Distilled alcoholic beverages, namely, whiskey, gin, rum, vodka and brandy; wine and wine products, namely, flavored wines and wine based beverages"; No. 2,528,250 for "Vodka, gin, scotch, bourbon, wine, wine coolers, pre-mixed cocktails containing alcohol"; and No. 2,162,763 for "wine, sparkling wine, brandy and vodka."²

These registrations suggest that wine and vodka originate from the same source. In addition, our case law suggests that wine and vodka are not unrelated goods.

² We have not considered several registrations as probative evidence because they do not indicate that the mark has been used (Nos. 2,690,975 and 2,695,683), they are apparently multiple registrations to the same entity (No. 2,827,201 (two copies)), or they appear to be for goods that are not simply vodka and wine (Nos. 2,747,373; 2,555,017; 2,219,830 ("wine" deleted); and 1,553,182).

[T]he products of both parties are alcoholic beverages which flow through the same channels of trade to the same class of purchasers, and we believe that a prospective purchaser of an alcoholic beverage upon entering and browsing through the various alcoholic products located or displayed on the various shelves or counters in retail liquor establishments would, upon encountering a whiskey, rum, brandy or vodka identified by the term "MONARCH", and then continuing on his jaunt to another counter or section of the same store and seeing a wine or champagne sold under the identical mark "MONARCH," be likely to believe that both products originated with the same producer.

Monarch Wine Co. v. Hood River Distillers, Inc., 196 USPQ 855. 857 (TTAB 1977). See also Myers v. Hood River Distillers, Inc., 331 F.2d 606, 141 USPQ 499 (CCPA 1964) (BARON ROTHSCHILD VODKA for vodka confusingly similar to MONOPOLES ALFRED ROTHSCHILD for wines, cognac, and brandy). Accord Chatam International, 71 USPQ2d at 1947-48 (Tequila and beer and ale related).

In addition, as in Majestic Distilling, applicant "has not demonstrated that consumers distinguish alcoholic beverages by manufacturer rather than by brand." 65 USPQ2d at 1204. We find that applicant's vodka and registrant's wine are related to the extent that when very similar marks are used in connection with these goods, potential customers are likely to believe that there is at least some association between the source of the goods.

Applicant also argues (Brief at 21) that "the wine buying general public - insofar as their selection and

purchase of wine is concerned - is a highly discriminating group." Applicant has not submitted evidence to establish this point and we add that the goods are broadly identified as wine and vodka. Our case law recognizes that purchasers of wine are not per se sophisticated purchasers who exercise great care in making their purchasing decisions. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005) ("[T]he Board found that champagne and sparkling wines are not necessarily expensive goods which are always purchased by sophisticated purchasers who exercise a great deal of care in making their purchases. This court agreed with the Board's finding. Although some champagne can be expensive, many brands sell for around \$25 a bottle, and sparkling wines for less than \$10 a bottle. Moreover, general consumers, not just connoisseurs, occasionally purchase champagne or sparkling wines on celebratory occasions, with little care or prior knowledge"); In re Opus One Inc., 60 USPQ2d 1812, 1817 (TTAB 2001) ("[R]egistrant's 'wine' must be presumed to encompass inexpensive or moderately-priced wine. In view thereof, applicant's arguments regarding the high cost of its actual restaurant services and of registrant's actual wine, and the resulting carefulness and

sophistication of the purchasers, miss the mark"). We also note that a "typical consumer of alcoholic beverages may drink more than one type of beverage and may shop for different alcoholic beverages in the same liquor store. Moreover, a person may serve more than one kind of alcoholic beverage before or during a meal or at a party." Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989).

While applicant argues that there is no evidence of fame of registrant's mark (Brief at 22), the absence of this evidence is of no consequence. This type of evidence would not normally be of record in an ex parte case and the lack of such evidence does not indicate that there is no likelihood of confusion. See Majestic Distilling, 65 USPQ2d at 1205 (citation omitted) ("Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous"). Furthermore, applicant's allegation regarding the lack of use of registrant's mark is also of no consequence.

Here, the DELTA mark is registered, in part, for restaurant services. The certificate of registration is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in connection with the services

specified. 15 U.S.C. Section 1057(b)(1994). Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration. It is true that a prima facie presumption of validity may be rebutted. See Dan Robbins & Assocs., Inc. v. Questor Corp., 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). However, the present *ex parte* proceeding is not the proper forum for such a challenge.

Dixie Restaurants, 41 USPQ2d at 1534.

Applicant also argues (Brief at 22) that “[b]ased upon Frank-Lin’s review and analysis of USPTO records, there are no other similar marks utilized in connection with similar goods. Therefore, this factor also weighs in favor of Frank-Lin’s registration of BEYOND VODKA.” Applicant asks that we take “judicial notice of all USPTO filings and records.” Brief at 22 n.3. Of course, we do not take judicial notice of third-party registrations and applications. In re Carolina Apparel, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998). Furthermore, the absence of other third-party registrations would ordinarily be a fact that would indicate that there is a likelihood of confusion and not, as applicant suggests, a fact that favors its position. We add that there is no evidence that registrant’s mark is a weak mark that is only entitled to a narrow scope of protection.

Finally, applicant alleges that there has been concurrent use of the marks and that there is no evidence of actual confusion. Again, even if there was evidence of this fact, it would not demonstrate that there is no likelihood of confusion. Majestic Distilling, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight").

Our analysis of all the factors leads us to conclude that when applicant's and registrant's marks are used on the identified goods, there would be a likelihood of confusion. If we had any doubts concerning this issue, "this is a proceeding in which registrant has no opportunity to be heard on this question and it is the practice to resolve doubt under Section 2(d) with the registrant." In re Mayco Mfg., 192 USPQ 573, 576 (TTAB 1976).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.